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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,144	01/22/2002	Ping Yang	03-12863	9196
25189	7590	11/07/2005		
CISLO & THOMAS, LLP 233 WILSHIRE BLVD SUITE 900 SANTA MONICA, CA 90401-1211			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,144

Applicant(s)

YANG, PING

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12 and 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12 and 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Newly submitted claims 37- 92 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: delivering to fixed pick-up points without regard for determining routes from customer route information and/or without regard to dispatching ordered product in a portable locker station.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-92 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment

The Applicant amended claims 12, 14, 19, 21, and 25, canceled claims 9-11, and 13, and newly added claims 29-92. All pending claims (1-8, 12, and 14-36) not withdrawn as noted above were examined in this non-final office action.

Response to Arguments

Pertaining to Rejection under 35 USC 101

Applicant's arguments filed 25 February 2005 persuasive. Rejection under 35 USC 101 is withdrawn.

Pertaining to Rejection under 35 USC 103(a)

Applicant's arguments with respect to claims 1-8, 12, and 14-25 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 1. Claims 1, 5, 21, and 25 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 11, 33, and 42 of copending Application No. 09/733,873. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: dispatching a portable locker station to a pickup location selected by the consumer, the pickup point being determined from the consumer's selecting a route based on the consumer route information.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-8, 12, and 14-36 are rejected under 35 USC 102(e) as being anticipated by Moreno (US 6,882,269).**

Moreno teaches all the limitations of claims 1-8, 12, and 14-28. For example, Moreno discloses modern consumers being challenged by busy work and social schedules and often do not have the time or opportunity to arrange for the personal delivery or pickup of items at times convenient to both the merchant and the customer. Moreno disclose various types of storage lockers with various access mechanisms for security used to ship and store goods ordered by modern consumers engaged in electronic commerce. Moreno teaches mobile lockers (e.g. shipping container or U-Haul vehicle/trailer) which are capable of being transported to a designated address for subsequent on-site storage of goods (see at least col. 4, lines 28-59; col. 22, lines 41-45). Moreno discloses assuring that a receptacle for delivering an order (please note examiner's

interpretation: mobile locker as a receptacle for delivering an order contained in the mobile locker) or receiving an order will be available on a specific date, at a specific time, and thereby eliminating the need to return to a location because of a missed delivery (see at least col. 2, lines 53-67). Moreno further discloses:

- receiving route information from a buyer: Inherent in Moreno are the structures necessary to permit receiving a delivery destination along a route the buyer travels or is willing to travel. For example, to deliver a mobile locker containing the consumer's ordered goods to a specific location for the customer to pick up the delivered goods as noted above, the customer must specify to the system a location along a route the customer is willing to travel chooses (please note: how far a consumer is willing to travel to any specific drop-off location at or near landmarks- airports, transit terminals, construction site, or a business- defines the consumer's channel width) (see at least col. 5, lines 3-10).
- generating a route from buyer route information: (see at least col. 18, lines 35-38).
- selecting from a plurality of pickup points a pickup point based on the route: designated by consumer; delivery points using landmarks: airports, transit terminals, construction site, or a business- defines the consumer's channel width) (see at least col. 5, lines 3-10).
- dispatching a portable locker station to the pickup point, the portable locker enclosing the ordered product: mobile lockers (e.g. shipping

container or U-Haul vehicle/trailer) which are capable of being transported to a designated address for subsequent on-site storage of goods (see at least col. 4, lines 28-59; col. 22, lines 41-45). Moreno teaches assuring that a receptacle for delivering an order (please note examiner's interpretation: mobile locker as a receptacle for delivering an order contained in the mobile locker is being dispatched to make the delivery) or receiving an order will be available on a specific date, at a specific time, and thereby eliminating the need to return to a location because of a missed delivery (see at least col. 2, lines 53-67).

- reference points: delivery points using landmarks: airports, transit terminals, construction site, or a business- defines the consumer's channel width) (see at least col. 5, lines 3-10).
- Server: service provider's system (SPS) (see at least col. 6, lines 6-20).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
October 31, 2005